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THE WEBB LAW FIRM, P.C.
700 KOPPERS BUILDING
436 SEVENTH AVENUE
PITTSBURGH, PA 15219

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/773,912
Filing Date: February 06, 2004
Appellant(s): DOMASHNEV, CONSTANTINE A.

Alexander Detschelt, #50,261
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/13/2009 appealing from the Office action mailed

9/30/2008.

(1) Real Party in Interest

The real party in interest for the application in this Appeal is the applicant, Constatine Domashnev.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0052760	Munoz et al.	5-2002
2003/ 0195838	Henley	10-2003
2003/ 0154376	Hwangbo	08-2003

2002/0035484	McCormick	05-2002
2002/0065758	Henley	05-2002
2002/ 0039503	Chan et al.	11-2001
2005/ 0039032	Babowicz et al.	02-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   ***Claims 1, 12, 13 and 16*** are rejected under 35 U.S.C 103(a) as being unpatentable over

Munoz et al, U.S. Pre-Grant Publication Number 2002/ 0052760 in view of Henley, U.S. Pre-

Grant Publication 2003/ 0195838.

2.   As per claim 1, Munoz teaches an electronic prescription handling system comprising:

(a) A first computer configured to transmit a prescription by a physician (figure 14 for

network design and paragraph 58 for the prescribing physician);

(b) A server communicatively connected to the first computer and functionally distinct

therefrom (figure 14, server 332 and pc 306 or third party system 320), wherein the

server is configured to receive the prescription from the first computer, wherein the

server is remote from the first computer (figure 14 where the server is connected through

the Internet as discussed in paragraph 58) and is operated by a service provider (figure 14

#318 and paragraph 72 to show the computer is operated by the service provider);

(c) A first pharmacy having a first pharmacy computer communicatively connected to

the server, wherein the first pharmacy computer is configured to:

- o Retrieve the prescription from the server (figure 14 where the third party may be any number of third parties as described in paragraph 72); and

- o Transmit a first bid for the prescription to the server (paragraph 67), wherein the first bid is stored on the server (67 where the bid results are compiled or stored);

(d) A second pharmacy having a second pharmacy computer communicatively connected to the server, wherein the second pharmacy computer is configured to:

- o Retrieve the prescription from the server (figure 14 where the third party may be any number of third parties as described in paragraph 72); and

- o Transmit a second bid for the prescription to the server (paragraph 67), wherein the second bid is stored on the server (67 where the bid results are compiled or stored); and

(e) A second computer communicatively connected to the server (figure 14).

Munoz does not explicitly teach the system wherein

(e) A second computer communicatively connected to the server, wherein the second computer is <u>operated by a patient and is configured to</u>:

- o <u>Retrieve the first bid and the second bid; and</u>

- o <u>Select one of (i) the first bid, and (ii) the second bid;</u>

- o <u>Such that</u>

  - ▪ <u>When the first bid is selected, the first pharmacy fills the prescription; and</u>

  - ▪ <u>When the second bid is selected, the second pharmacy fills the prescription.</u>

However, Henley teaches the system wherein

(e) A second computer communicatively connected to the server, wherein the second

computer is operated by a patient and is configured to (figure 8 and paragraphs 63 and 83

where the buyer is a patient):

- o Retrieve the first bid and the second bid; and

- o Select one of (i) the first bid, and (ii) the second bid (paragraph 101 where the

  bids are for the medical service that according to paragraph 93 could also be for

  prescriptions);

- o Such that

  - ▪ When the first bid is selected, the first pharmacy fills the prescription

    (paragraph 102 where the parties of the transaction are the winning

    bidders); and

  - ▪ When the second bid is selected, the second pharmacy fills the

    prescription (paragraph 102 where the parties of the transaction are the

    winning bidders).

It would have been obvious to one of ordinary skill in the art at the time of the invention to

incorporate these features into Munoz. One of ordinary skill in the art would have incorporated

these features into Munoz with the motivation to enable prospective clients/ patients and

professional service providers to competitively negotiate fees for proffered services through an

interactive on-line professional services auction transaction system implemented over a publicly

accessible communications network such as the Internet (Henley abstract).

3.   As per claim 12, Munoz in view of Henley teaches the system of claim 1 as described

above. Munoz further teaches the system wherein the first pharmacy is one of a brick-and-

mortar pharmacy and an online pharmacy (paragraph 67 where the local pharmacies are brick-and-mortar and a US pharmacy may be either brick-and-mortar and online or both brick-and-mortar and online and further where the pharmacy type is non-functional).

4.   As per claim 13, Munoz teaches a method for issuing a prescription comprising the steps of:

- Transmitting a prescription from a first computer by a physician (figure 14 for network design and paragraph 58 for the prescribing physician);

- Receiving the prescription on a server functionally distinct from the first computer (figure 14, server 332 and pc 306 or third party system 320), wherein the server is remote from the first computer (figure 14 where the server is connected through the Internet as discussed in paragraph 58) and is operated by a service provider (figure 14 #318 and paragraph 72 to show the computer is operated by the service provider);

- Retrieving the prescription from the server (figure 14 where the third party may be any number of third parties as described in paragraph 72);

- Submitting a first bid for the prescription to the server from a first pharmacy having a first pharmacy computer (67 where the bid results are compiled or stored);

- Submitting a second bid for the prescription to the server from a second pharmacy having a second pharmacy computer (67 where the bid results are compiled or stored);

- Storing the first bid and the second bid on the server (paragraph 100 where the global database is on the server);

- Transmitting the first bid and the second bid to a second computer (67 where the bid results are compiled or stored);

- Viewing the first bid and the second bid on the second computer (paragraph 67).

Munoz does not explicitly teach the method comprising

- Transmitting the first bid and the second bid to a second computer <u>operated by a patient</u>;

- <u>Making a selection consisting of one of (i) the first bid, and (ii) the second bid;</u>

- <u>Transmitting the selection to the server; and</u>

- <u>Informing one of (i) the first pharmacy, and (ii) the second pharmacy to fill the prescription.</u>

Munoz does not explicitly teach the method comprising

- Transmitting the first bid and the second bid to a second computer operated by a patient (figure 8 and paragraphs 63 and 83 where the buyer is a patient);

- Making a selection consisting of one of (i) the first bid, and (ii) the second bid (paragraph 101 where the bids are for the medical service that according to paragraph 93 could also be for prescriptions);

- Transmitting the selection to the server (paragraph 102 where the server makes the selection and the pharmacies notice the selection); and

- Informing one of (i) the first pharmacy, and (ii) the second pharmacy to fill the prescription (paragraph 102 where the parties of the transaction are the winning bidders).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz. One of ordinary skill in the art would have incorporated these features into Munoz with the motivation to enable prospective clients/ patients and professional service providers to competitively negotiate fees for proffered services through an

interactive on-line professional services auction transaction system implemented over a publicly accessible communications network such as the Internet (Henley abstract).

5.   As per claim 16, Munoz in view of Henley teaches the method of claim 13 as described above.   Munoz in view of Henley further teaches the method comprising the steps of transmitting to the second computer at least one of:

- Contact information of one of (i) the first pharmacy, and (ii) the second pharmacy (paragraph 67);

- A set of directions from one of (i) the first pharmacy, and (ii) the second pharmacy to an address specified by the second computer; and

- A map-illustrating an address on the map of one of (i) the first pharmacy, and (ii) the second pharmacy.

6.   ***Claims 2 – 9 and 14 – 15*** are rejected under 35 U.S.C 103(a) as being unpatentable over Munoz et al, U.S. Pre-Grant Publication Number 2002/ 0052760 in view of Henley, U.S. Pre-Grant Publication 2003/ 0195838 as applied to claims 1 and 13 as above and further in view of Hwangbo, U.S. Pre-Grant Publication Number 2003/ 0154376.

7.   As per claim 2, Munoz in view of Henley teaches the system of claim 1 as described above.

Munoz in view of Henley does not explicitly teach the electronic prescription handling system further comprising a portable storage medium configured to be interfaced with the first computer, wherein the portable storage medium includes an application for transmitting a digital certificate to the server when the portable storage medium interfaces with the first computer.

However, Hwangbo teaches the electronic prescription handling system further comprising

- A portable storage medium configured to be interfaced with the first computer (paragraph 1),

  o Wherein the portable storage medium includes an application (paragraph 1)

    ▪ For transmitting a digital certificate (paragraph 1)

    ▪ To the server (figure 13)

    ▪ When the portable storage medium interfaces with the first computer (paragraph 67 where the certificates automatically access the server).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

8.   As per claim 3, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 2 as described above.

Munoz in view of Henley does not explicitly teach the electronic prescription handling system wherein the portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory.

However, Hwangbo teaches the electronic prescription handling system wherein the portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory (paragraph 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would

have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

9.   As per claim 4, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 2 as described above.

Munoz in view of Henley does not explicitly teach the electronic prescription handling system wherein the server is configured to authenticate the digital certificate.

However, Hwangbo teaches the electronic prescription handling system wherein the server is configured to authenticate the digital certificate (figure 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

10.   As per claim 5, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 4 as described above.

Munoz further teaches the electronic prescription handling system wherein the server is configured to transmit a prescription entry web page to the first computer upon the server authenticating (paragraph 63 where the physician logs in).

Munoz does not explicitly teach the electronic prescription handling system wherein the server is configured to transmit a prescription entry web page to the first computer upon the server authenticating the digital certificate.

However, Hwangbo teaches the electronic prescription handling system wherein the server is configured to transmit a prescription entry web page to the first computer upon the server authenticating the digital certificate (paragraph 87 where the mall is a web entry page as described in paragraph 33 where the medium is pre-inserted).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

11.   As per claim 6, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 5 as described above.

Munoz further teaches the system wherein

- A pharmaceutical database for storing a plurality of drug formularies therein (paragraph 64).

Munoz does not explicitly teach the system wherein

- A physician database <u>utilized to authenticate the digital certificate.</u>

However, Hwanbo teaches the system wherein

- A physician database utilized to authenticate the digital certificate (paragraph 115 where the user is a physician).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

12.   As per claim 7, Munoz in view of Henley, further in view of Hwangbo teaches the system

of claim 6 as described above.

Munoz further teaches the system wherein the server comprises:

- A prescription database for storing the prescription received from the first computer

  (figure 14 where database 304 or database 334 stores the information);

- A patient database for storing patient information (figure 14 where database 304 or

  database 334 stores the information);

- A pharmacy database for storing pharmacy data (figure 14 where database 304 or

  database 334 stores the information); and

- A bid database for storing the first bid and the second bid (figure 14 where database 304

  or database 334 stores the information).

13.   As per claim 8, Munoz in view of Henley, further in view of Hwangbo teaches the system

of claim 7 as described above.

Munoz further teaches the system wherein the patient information comprises at least one of (i) an

insurance provider identifier for the patient, (ii) a medical history for the patient, (iii) a drug

interaction list for the patient, and (iv) an allergic reaction list for the patient (figure 13 where the

insurance company and patient history is entered).

14.   As per claim 9, Munoz in view of Henley, further in view of Hwangbo teaches the system

of claim 7 as described above.

Munoz further teaches the system wherein the pharmacy data comprises contact information for

one of (i) the first pharmacy and, (ii) the second pharmacy (paragraph 67).

15.   As per claim 14, Munoz in view of Henley teaches the method of claim 13 as described above.

Munoz in view of Henley does not explicitly teach the steps of:

- Interfacing a portable storage medium with the first computer, wherein the portable storage medium includes an application for transmitting a digital certificate; and

- Transmitting the digital certificate to the server.

Chan teaches the steps of:

- Interfacing a portable storage medium with the first computer (paragraph 1), wherein the portable storage medium includes an application (paragraph 1) for transmitting a digital certificate (paragraph 1); and

- Transmitting the digital certificate to the server (figure 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

16.   As per claim 15, Munoz in view of Henley, further in view of Hwangbo teaches the method of claim 14 as described above.

Munoz further teaches the step of transmitting a prescription entry web page to the first computer (paragraph 63 where the physician logs in).

Munoz does not explicitly teach the step of authenticating the digital certificate on the server.

However, Hwangbo teaches the step of authenticating the digital certificate on the server (paragraph 87 where the mall is a web entry page as described in paragraph 33 where the medium is pre-inserted).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

17.   *Claims 10 and 11* are rejected under 35 U.S.C 103(a) as being unpatentable over Munoz et al, U.S. Pre-Grant Publication Number 2002/ 0052760 in view of Henley, U.S. Pre-Grant Publication 2003/ 0195838 as applied to claim 1 above and further in view of Hwangbo, U.S. Pre-Grant Publication Number 2003/ 0154376 as applied to claims 2 through 9 above, and further in view of McCormick, U.S. Pre-Grant Publication Number 2002/0035484.

18.   As per claim 10, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 9 as described above.

Munoz in view of Henley, further in view of Hwangbo do not explicitly teach the system wherein the server is further configured to transmit at least one of <u>(i) an address of the first pharmacy or second pharmacy, and (ii) a set of directions from the first pharmacy or second pharmacy to an address specified by the second computer</u>.

However, McCormick teaches the electronic prescription handling system wherein the server is further configured to transmit at least one of (i) an address of the first pharmacy or second pharmacy, and (ii) a set of directions from the first pharmacy or second pharmacy to an address specified by the second computer (paragraph 89).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Munoz in view of Henley, further in view of Hwangbo. One of ordinary skill in the art would have incorporated this feature Munoz in view of Henley, further in view of Hwangbo with the motivation to eliminate inefficiencies at the doctor's office in generating the prescription (McCormick paragraph 5).

19.   As per claim 11, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 10 as described above.

Munoz in view of Henley, further in view of Hwangbo does not explicitly teach the electronic prescription handling system wherein the server is further configured to transmit a map illustrating the address on the map of one of (i) the first pharmacy, and (ii) the second pharmacy. However, McCormick teaches the electronic prescription handling system wherein the server is further configured to transmit a map illustrating the address on the map of one of (i) the first pharmacy, and (ii) the second pharmacy (paragraph 90).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Munoz in view of Henley, further in view of Hwangbo. One of ordinary skill in the art would have incorporated this feature Munoz in view of Henley, further in view of Hwangbo with the motivation to eliminate inefficiencies at the doctor's office in generating the prescription (McCormick paragraph 5).

20.   *Claims 17 – 22* are rejected under 35 U.S.C 103(a) as being unpatentable over Henley, U.S. Pre-Grant Publication Number 2002/0065758 in view of Chan et al., U.S. Pre-Grant Publication Number 2001/0039503 and Babowicz et al., U.S. Pre-Grant Publication Number 2005 / 00390032.

21.   As per claim 17, Henley teaches an electronic prescription handling system comprising:

- A computer (paragraph 32);

- A server communicatively connected to the computer (paragraph 32);

- Further wherein a user of the computer enters a prescription (paragraph 93 where a
  medical service is defined as a pharmacy) into the prescription entry web page (and
  paragraph 94 where the prescription service is entered), and thereafter the computer
  transmits the prescription to the server (paragraph 94).

Henley does not explicitly teach an electronic prescription handling system comprising:

- A portable storage medium configured to interface with the computer;

- An application residing on the portable storage medium, wherein the computer is
  configured to automatically execute the application once the portable storage medium
  interfaces with the computer, wherein the application includes a file associated therewith
  for instructing the computer to execute the application, further wherein the application is
  configured to transmit a digital certificate to the server upon the application sensing a
  network connection to the server; and

- Means for authenticating the digital certificate on the server, wherein when the digital
  certificate is positively authenticated, the server transmits a prescription entry web page
  to the computer.

However, Chan teaches an electronic prescription handling system comprising:

- A portable storage medium configured to interface with the computer (paragraph 83
  where the portable medium is a CD-ROM);

- An application residing on the portable storage medium (paragraph 83 where the software is stored on the CD-ROM), and

- Means for authenticating the digital certificate on the server (paragraph 73), wherein when the digital certificate is positively authenticated (paragraph 73), the server transmits a prescription entry web page to the computer (paragraph 65 where the GUI is a web page and the level is restricted to the physician).

And Babowicz teaches an electronic prescription handling system comprising:

- An application residing on the portable storage medium (paragraph 26),

    o Wherein the computer is configured to automatically execute the application once the portable storage medium interfaces with the computer (paragraph 26, auto-run file),

    o Wherein the application includes a file associated therewith for instructing the computer to execute the application (paragraph 26 auto-run information file), further

    o Wherein the application is configured to transmit a digital certificate to the server upon the application sensing a network connection to the server (paragraph 27, secret key).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Henley.

One of ordinary skill in the art would have motivated to incorporate these features into Henley to facilitate access to and utilization of the associated data stores and resources by the major

participants in the health and wellness program (Chan paragraph 9) and to provide local use of an

authentication program running on the client, who reduces communications and processing

demands of the server (Babowicz Abstract).

22.   As per claim 18, Henley in view of Chan and Babowicz teach the system of claim 17 as

described above.

 Henley does not explicitly teach the electronic prescription handling system <u>wherein the</u>

<u>portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory.</u>

However, Chan teaches the electronic prescription handling system wherein the portable storage

medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory (paragraph 83 where

the portable storage medium is a CD-ROM).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the

invention to incorporate this feature into Henley in view of Chan and Babowicz. One of

ordinary skill in the art would have motivated to incorporate this feature into Henley in view of

Chan and Babowicz to facilitate access to and utilization of the associated data stores and

resources by the major participants in the health and wellness program (Chan paragraph 9).

23.   As per claim 19, Henley in view of Chan and Babowicz teach the system of claim 17 as

described above.

Henley does not explicitly teach the electronic prescription handling system wherein <u>the digital</u>

<u>certificate identifies a physician.</u>

However, Chan teaches the electronic prescription handling system wherein the digital certificate

identifies a physician (paragraph 73 where the user is a physician).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Henley in view of Chan and Babowicz. One of ordinary skill in the art would have motivated to incorporate this feature into Henley in view of Chan and Babowicz to facilitate access to and utilization of the associated data stores and resources by the major participants in the health and wellness program (Chan paragraph 9).

24.   As per claim 20, Henley in view of Chan and Babowicz teach the system of claim 18 as described above.

Henley does not explicitly teach the electronic prescription handling system wherein the <u>digital certificate is hidden on the portable storage medium</u>.

However, Babowicz teaches the electronic prescription handling system wherein the digital certificate is hidden on the portable storage medium (paragraph 27 where the key is a secret key and paragraph 24 where the contents of the disk are copy protected. Additionally, it should be pointed out that any file on the portable storage medium cannot be seen without a reading device and so by default are hidden).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Henley in view of Chan and Babowicz. One of ordinary skill in the art would have motivated to incorporate this feature into Henley in view of Chan and Babowicz to provide local use of an authentication program running on the client, who reduces communications and processing demands of the server (Babowicz Abstract).

25.   As per claim 21, Henley in view of Chan and Babowicz teaches the system of claim 20 as described above.

Henley does not explicitly teach the electronic prescription handling system wherein the <u>digital</u>
<u>certificate cannot be copied from the portable storage medium.</u>

However, Babowicz teaches the electronic prescription handling system wherein the digital
certificate cannot be copied from the portable storage medium (paragraph 24 where the files are
copy protected).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the
invention to incorporate this feature into Henley in view of Chan and Babowicz. One of
ordinary skill in the art would have motivated to incorporate this feature into Henley in view of
Chan and Babowicz to provide local use of an authentication program running on the client, who
reduces communications and processing demands of the server (Babowicz Abstract).

26.   As per claim 22, Henley in view of Chan and Babowicz teaches the system of claim 19 as
described above. Henley further teaches the electronic prescription handling system wherein the
server transmits the prescription to a pharmacy (paragraph 93 where plurality includes a first
pharmacy computer).

    (10) Response to Argument

<u>Claims 1 and 13</u>

- The Appellant states, "The Final Office Action dated September 30, 2008 fails to identify
  a reason apparent to a person having ordinary skill in the art of ASP medical-based
  computing implementations for making the combination of the teachings of the Munoz
  publication with those of Henley I publication to obtain the limitations of independent
  claims 1 and 13, resulting in a clear deficiency in establishing a prima facie case of
  obviousness in support of the rejection of claims 1 and 13.

- o The Examiner's statement of obvious is, "It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz. One of ordinary skill in the art would have incorporated these features into Munoz with the motivation to enable prospective clients/ patients and professional service providers to competitively negotiate fees for proffered services through an interactive on-line professional services auction transaction system implemented over a publicly accessible communications network such as the Internet (Henley abstract)." The Examiner found his reason for obvious within the Henley I publication.

- o The Appellant's argument narrows of the individual required to have a level of ordinary skill in the art. The Examiner finds no explicit, implicit or inherent statement limiting the person of ordinary skill to only those of a "person having ordinary skill in the art of ASP medical-based computing implementations." ASP is not used within the Specification.

- o The Specification, paragraph 10 states, "**[0010]** To overcome the deficiencies of the prior art, what is needed, and has not heretofore been developed, is a system and method for providing a physician with authenticated access to generate a prescription from any Internet connected computer, whereby a patient for whom the prescription is written invites bidding on his or her prescription in order to realize cost savings over market-priced drugs."

- o It is the Examiner's position that one of ordinary skill is shown by the references. For Example, Henley, paragraph 80 states:

FIG. *7* is a block diagram illustrating an exemplary web-page server computer

transaction system that is operable on line for conducting buy-sell and/or auction

transactions between a medical service provider/ facility offering medical services for

sale, and patients desiring to buy such medical services. Although a single example

transaction is disclosed wherein a medical service provider offers a specified medical

service for sale at a preferred price and the offer is presented to a plurality of buyers for

acceptance by a single buyer, a practitioner of ordinary skill in the art will realize that

web-page server computer transaction system *16 may be used to implement many*

different types of marketing and auction transactions. (emphasis added)

- Therefore, one ordinary skill may also be someone that also programs

  outside of "ASP medical-based computing implementations."

For clarity, claim 1 is copied here:

Claim 1: An electronic prescription handling system comprising:
    (a) a first computer configured to transmit a prescription by a physician;
    (b) a server communicatively connected to the first computer and functionally distinct
therefrom, wherein the server is configured to receive the prescription from the first computer,
wherein the server is remote from the first computer and is operated by a service provider;
    (c) a first pharmacy having a first pharmacy computer communicatively connected to the
server, wherein the first pharmacy computer is configured to:
        retrieve the prescription from the server; and
        transmit a first bid for the prescription to the server, wherein the first bid is stored
on the server;
    (d) a second pharmacy having a second pharmacy computer communicatively connected
to the server, wherein: the second pharmacy computer is configured to:
        retrieve the prescription from the server; and
        transmit a second bid for the prescription to the server, wherein the second bid is
stored on the server; and
    (e) a second computer communicatively connected to the server, wherein the second
computer is operated by a patient and is configured to:
        retrieve the first bid and the second bid; and

select one of (i) the first bid, and (ii) the second bid, such that when the first bid is
selected, the first pharmacy fills the prescription, and when the second bid is selected, the
second pharmacy fills the prescription.

The Appellant introduced the idea of "functionally distinct therefrom" within the amendment

dated 10/25/2007, also included here:

Claim 1: An electronic prescription handling system comprising:
    (a) a first computer configured to transmit a prescription by a physician;
    (b) a server communicatively connected to the first computer and <u>functionally distinct</u>
<u>therefrom</u>, wherein the server is configured to receive the prescription from the first computer
~~and~~<u>,</u> wherein the server is remote from the first computer <u>and is operated by a service provider</u>;
    (c) a first pharmacy having a first pharmacy computer communicatively connected to the
server, wherein[[:]] the first pharmacy computer is configured to<u>:</u>
        retrieve the prescription from the server; and
        ~~the first pharmacy computer is configured to~~ transmit a first bid for the
prescription to the server, wherein the first bid is stored on the server;
    <u>(d)</u> a second pharmacy having a second pharmacy computer communicatively connected
to the server, wherein[[:]] the second pharmacy computer is configured to;
        retrieve the prescription from the server; and
        ~~the second pharmacy computer is configured to~~ transmit a second bid for the
prescription to the server, wherein the second bid is stored on the server; and
    <u>(e)</u> a second computer communicatively connected to the server, wherein[[:]] the second
computer is <u>operated by a patient</u> and is configured to;
        retrieve the first bid and the second bid;
        ~~the second computer is configured to~~ select one of (i) the first bid, and (ii) the
second bid[[;]]<u>, such that</u> when the first bid is selected, the first pharmacy fills the
prescription[[;]], and when the second bid is selected, the second pharmacy fills the
prescription.

The Examiner understood "functionally distinct thereon" with respect to the Appellant's

specification, paragraphs 24 – 26, included here with emphasis added:

[0024] With reference to FIG. 1, the entities and the communicative connectivity

between the entities within an electronic prescription handling system 10 will now be

described. In a desirable embodiment, the electronic prescription handling system 10

includes a server 12, a first computer 14, a second computer 16, and a plurality of

pharmacies, such as a first pharmacy 18a and a second pharmacy 18b. Utilizing a

computer network 20, such as the Internet, the central server 12 is communicatively

connected to the first computer 14, the second computer 16, and computers of the

plurality of pharmacies 18a, 18b.

[0025] The server 12 may be any suitable computer system that is configured to transmit

and receive data to and from the first computer 14, the second computer 16, and the

plurality of pharmacies 18a, 18b. In the context of the Internet or other computer

network, the server 12 may function as a web server, thereby transmitting data, e.g., web

pages, and receiving data, e.g., user inputted data forms. The server 12 may be operated

and maintained by a service provider implementing the electronic prescription handling

system 10. *The server 12 may be construed to embody more than one physical*

machine to allow for distributed computing. It is to be understood that communications

between the above communicative entities may be implemented in a variety of ways

including, but not limited to, land-line, wireless, and satellite-based systems. *Thus, the*

communication links described hereinafter are merely exemplary and are not to be

construed as limiting the invention in any manner. The server 12 is communicatively

connected to a physician database 22 and a pharmaceutical database 24. The physician

database 22 includes a plurality of physician profiles with corresponding identifiers to be

used in authenticating a physician who accesses the server 12. Specifically, the server 12

is configured to authenticate digital certificates transmitted to the server 12 by the

physician. Those having ordinary skill in the art would appreciate the necessary

hardware and programming required to implement a suitable authentication system. The

pharmaceutical database 24 includes a plurality of drug formularies. Additionally the pharmaceutical database 24 may have information pertaining to possible adverse drug interactions and side effects associated with any of the drugs in the drug formularies. Furthermore, the server 12 may include a prescription database 26, a patient database 28, a pharmacy database 30, and a bid database 32. The prescription database 26 may store electronic prescriptions submitted and written by the physician. The patient database 28 may store patient profiles, wherein the profiles may include but are not limited to, the name of a patient, contact information, payment form, insurance provider information, drug coverage information, and drug interaction and allergic reaction information. The pharmacy database 30 stores pharmacy data for the plurality of pharmacies 18a, 18b, such as the names, contact information, and addresses of the first pharmacy 18a and the second pharmacy 18b. The bid database 32 is configured to store bids received from the plurality of pharmacies 18a, 18b. A bid may include, but is not limited to, the dispensing pharmacy, the delivery type and/or availability, the quantity, the drug manufacturer, and the price. *It is to be understood that the above-described databases do not necessarily need to exist as individual databases, as one or more of the databases may be integrated into another database. Furthermore, the databases may also be physically located external of the server 12.*

[0026] *The first computer 14 may include, but is not limited to, a desktop computer, a notebook computer, or a personal digital assistant.* The first computer is utilized by an individual, namely, the physician, in prescribing a pharmaceutical to the patient. The first computer 14 is configured to access the server 12 in order for the physician to write

and submit the prescription. With reference to FIG. 2 and with continuing reference to

FIG. 1, FIG. 2 shows a portable storage medium 34, such as a modified compact disc,

that is configured to interface with the first computer 14. For example, the modified

compact disc may have the dimensions of a typical business card, so that the physician

may easily carry the portable storage medium. The ability to store the compact disc in a

wallet avoids the nuisance involved in carrying a regular-sized compact disc. It is to be

understood that the modified compact disc is mentioned for exemplary purposes and that

the portable storage medium may encompass various formats, including, but not limited

to, a DVD and flash memory. The portable storage medium 34 may include an

application configured to securely, through appropriate encryption, transmit a digital

certificate to the server 12 when the portable storage medium 34 interfaces with the first

computer 14. The digital certificate may identify the physician who is utilizing the

portable storage medium 34 to write and submit the prescription. For example, upon

inserting the modified compact disc into a CD-ROM drive of the first computer 14, the

CD-ROM is read by the first computer 14. It is to be understood that the first computer

14 may be configured to automatically execute the application residing on the CD-ROM

via automatic execution protocols inherent in the operating system of the first computer

14. An example of such an automatic execution protocol is the "auto-run" feature found

in the Windows® operating system. Upon execution of the application, the digital

certificate is transmitted to the server 12. The digital certificate stored on the portable

storage medium 34 is unique and may be hidden and/or encrypted so that it cannot be

copied from the portable storage medium 34. Thus, any physician who is in possession

of the portable storage medium 34 is deemed to have signed the prescription resulting

from the use of the particular portable storage medium 34.

Therefore, the Examiner understood functionally distinct as allowing the computers to be

distributed and allowing the databases to be distributed.

- The Appellant states, "The Examiner asserts that Appellant's argument that the claimed

   first computer and server are separate entities is simply a matter of design choice and

   should therefore not be considered to be a patentable distinction."

   o The Examiner, based upon the description of the Specification, feels that the

      distribution of features within a computer system or the combining of these

      features into a single system is a matter of design choice that falls under MPEP

      §2144.04(V).

   o The Appellant's reason for making the databases and computers separable rather

      than integral, that "it would not make sense to have the service provider work on

      the same computer as that of the physician" would therefore become a prima facie

      obvious reason for making separable.

- The Appellant states, "The Examiner has dismissed the merits of the Declaration, even

   though Mr. Domashnev has set forth in his Declaration the rationale of why neither

   Munoz nor Henley I publication contain any suggestion or motivation to combine the

   teaches of these references."

   o The Examiner's response to the declaration is, "The declaration under 37

      CFR 1.132 filed 7/7/2008 is insufficient to overcome the rejection of claims 1 - 22

based upon claim interpretation as applied under 35 U.S.C. 103(a) as set forth in

the last Office action because: It refer(s) only to the system described in the

above referenced application and not to the individual claims of the application.

Thus, there is no showing that the objective evidence of nonobviousness is

commensurate in scope with the claims. See MPEP § 716."

- o Second, the Appellant's cited paragraph from the Declaration only argues the

  Munoz reference individually, not the combination of Munoz and Henley I.

- o Third, the Appellant is asking for reasons for combining from the primary

  reference, Munoz, by stating, "Accordingly, Mr. Domashnev does not view the

  Munoz publication to contain any suggestion or motivation for one skilled in the

  art of ASP medical-based computing implementations to utilize the teachings of

  the Munoz publication in the context of an electronic prescription handling

  system according to the claimed invention."

- o Fourth, the Appellant states, "Therefore, Appellant does not understand how the

  Examiner can reasonably assert that the Declaration, incorporating the survey, as

  set for in §2 of the Declaration, does not sufficiently address the specific claims."

  The Examiner notes that the Declaration discusses the claimed invention in

  general and not toward specific claims. No where within the Appellant's

  declaration is claim 1 or 13 mentioned nor within any specific limitation of either

  claim 1 or claim 13.

- • The Appellant states, "Faced with the obviousness rejections in the most recent Office

  Actions, Appellant has addressed why it would not be obvious to combine the prior art

references as set for by the Examiner." The Examiner has noted the explicit reason for combining as detailed above.

- The Appellant states, "With respect to the present invention, the service provider acts as an intermediary to offload the involved task of a physician collecting, reviewing and forwarding bids to a patient." The Examiner notes that this service provider requirement is not claimed nor described within the Specification.

- The Appellant states, "However, Appellant has previously indicated that this feature is inherent in the claimed steps of the invention and, therefore, there is no reason to refer to the concept by name, regardless of whether or not a reverse auction is occurring." The Examiner finds no inherency and therefore continues to maintain that the steps may allow different auction types. The Appellant's further arguments that the Examiner must interpret the claimed invention in view of Attorney arguments and not in view of the Specification are equally not persuasive.

  o The use of the Declaration to show that the Examiner's interpretation of the claimed invention is different than the Appellants intended interpretation is not persuasive in that there is nothing within the originally filed Specification or the current Claims limiting the Examiner to one point of view. The Appellant's intended use of the invention should not be limiting when other intended uses are equally reasonable.

Claims 10 and 11

- The Appellant states, "Appellant hereby incorporates by reference the aforementioned arguments made with respect to independent claim 1 above." The Examiner notes the responses as described above.

- The Appellant states, "Appellant fails to understand how providing directions and maps would improve on generating prescriptions more efficiently."

  o The Appellant develops this question from the Examiner's motivational statement, included here, "It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Munoz in view of Henley, further in view of Hwangbo. One of ordinary skill in the art would have incorporated this feature Munoz in view of Henley, further in view of Hwangbo with the motivation to eliminate inefficiencies at the doctor's office in generating the prescription (McCormick paragraph 5)."

    ▪ To answer the Appellant's question, the Examiner has copied paragraph 54 from McCormick to better explain how mapping would "eliminate inefficiencies." (emphasis added)

      [0054] In step **230,** the doctor may ask the patient where and how to fill the prescription. ***The patient may already have a regular local pharmacy that he or she goes to. Alternatively, the patient may be unfamiliar with local pharmacies and the doctor may be able to suggest a pharmacy. The doctor's terminal can display a map showing multiple pharmacies and the patient may be able to select one from the map. Once the pharmacy is selected, the terminal will also be able to print out the map and the directions to the local pharmacy.*** Details of the printing operation

is described below in conjunction with **FIG. 6.** Such map and direction information

may either reside in the local terminal memory or may be sent from the remote

database. For example, in a press release dated Dec. 2,1998, 3Com has announced a

national field trial of Palm VIITM, which is a handheld device with a wide area two-

way radio, providing access to a number of Web sites. One of the links could easily

be made to a map service showing all the pharmacies.

- The Appellant states, "However, the Examiner fails to expound on why he believes that

  the results of the combination of existing elements would be predictable."

  - The Examiner wrote this comment in the Response to Arguments section of the

    Final Office Action dated 9/30/2008. Specifically, the Examiner wrote:

The Applicant is reminded to review recent U.S. Supreme court rulings before making additional

amendments. In particular, KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (2007)

where:

a.   The elements are all known but not combined as claimed. The technical ability

exists to combine the elements as claimed and the results of the combination are

predictable. When combined, the elements <u>perform the same function as they did</u>

<u>separately</u>.

  - As the Examiner stated above, it is the Examiner's position that when several

    software modules are combined, the results of the combination would be

    predictable because the outcomes of these particular modules combined would be

    the same outcome had they been separate.

- The Appellant states, "An Examiner must take into account secondary considerations offered in a Declaration in his obviousness analysis, which evidently, the Examiner has failed to do.

  o The Appellant's declaration has two paragraphs that discuss secondary considerations and they are included here: (emphasis added)

2. As being the inventor, I am considered to be a person having ordinary skill in the art of ASP medical computing implementations. I have Master's degree in Math (Mathematical Cybernetics) and Master's degree in Industrial Administration (Operations Management and Automation). Around 2003 I have conceived and developed a prototype ASP which I believed should reduce the workload to everyone who handles medical prescriptions: Medical Doctors, Pharmacists, Recipients of, and Pharmaceutical Insurance Providers. *I have conducted a small survey amongst local Medical Doctors and I have found that the critical group of potential users (Medical Doctors) would be interested in 2.a) using and 2.b) paying for my system.* I also have an understanding of the teachings in United States Patent Application Publication 200210052760 to Munoz et al. (hereinafter "the Munoz publication") and United States Patent Application Publication 2003/0195838 to Henley (hereinafter "the Henley publication").

   5. There is an unfulfilled need in the electronic prescription industry to provide a system and method for providing a physician with authenticated access to generate a prescription from any Internet-connected computer, whereby a

patient for whom the prescription is written invites bidding on his or her

prescription in order to realize cost savings over market-priced drugs in the

context of multi-objective prescription choices.

o   The Examiner has followed the guidelines found within MPEP §716.01 when

determining the relevance of the Appellant's declaration. In particular the

Appellant has failed to show a nexus between the declaration and the claimed

invention (MPEP §716.01(b)). Additionally, as the sample size of the Appellant's

survey, admittedly small, is unknown and the specific results are unknown, the

Appellant failed to show any objective proof of long felt need as required by

(MPEP §716.01(c)). Therefore, with no nexus and little objective evidence, the

Examiner concluded that the preponderance of evidence was more toward

obviousness as explained within (MPEP §716.01(d)).

Claims 17

- The Appellant states, "The Examiner's motivation for combining the teaching of the

  Babowicz publication with that of the other references is illogical in the context of the

  claimed invention." The Appellant continues, "However, the Auto-Run feature has

  nothing to do with reducing communications and processing demands, either in

  Babowicz or the claimed invention.   In fact, the purpose of providing the Auto-Run

  feature in Appellant's invention is to automatically execute an application to transmit a

  digital certificate to the server."

  o   In responding to the Appellant's statements, claim 17 is first copied here:

  (emphasis added)

Claim 17 (Currently Amended): An electronic prescription handling system comprising:

a computer;

a server communicatively connected to the computer;

a portable storage medium configured to interface with the computer;

an application residing on the portable storage medium, wherein the computer is

configured to automatically execute the application once the portable storage medium interfaces

with the computer, wherein the application includes a file associated therewith for instructing the

computer to execute the application, further wherein the application is configured to transmit a

digital certificate to the server upon the application sensing a network connection to the server;

and

means for authenticating the digital certificate on the server, wherein when the digital

certificate is positively authenticated, the server transmits a prescription entry web page to the

computer, further wherein a user of the computer enters a prescription into the prescription entry web

page, and thereafter the computer transmits the prescription to the server.

- o The Appellant chose not to directly claim the Auto-Run feature as shown above.

- o The Examiner's motivation statement is included below:

One of ordinary skill in the art would have motivated to incorporate these features

into Henley to facilitate access to and utilization of the associated data stores and

resources by the major participants in the health and wellness program (Chan

paragraph 9) and to provide local use of an authentication program running on the

client, who reduces communications and processing demands of the server

(Babowicz Abstract).

- ▪ The Examiner's reason for combining may be different than the

  Appellant's and has been taken explicitly from the reference.

- ▪ The Examiner includes below the reference paragraphs from Babowicz

  that show that the Auto-run feature of Babowicz performs a similar feature

  to that of the instant application.

[0026] Computer program **206** executes and controls the authentication method according to the present invention, as discussed in greater detail below. Computer program **206** is programmed using, for example, the C++ programming language. However, one skilled in the art will recognize in light of the following description that many other types of programming languages may be used to implement program **206**.Auto-run information file **212** provides the information necessary for automatically launching computer program **206** when a user inserts compact disc **116** into drive **110**.The auto-run feature is implemented using a standard approach such as, for example, available when using the WIDOWS 98 operating system from Microsoft Corporation running on an Intel-based personal computer. One skilled in the arts will recognize that similar. auto-run approaches can be implemented for other platforms such as, for example, the Apple and Sun Microsystems computer platforms.
[0027] HTML file **210** provides text and images to provide a user with information that the user may manually access in the event that computer program **206** does not automatically launch after insertion into drive **110** or remote connection **106** is not automatically established. Identifier file **208** includes a content identifier **214** and a secret key **216.** Content identifier **214** is sent to music server **104** and enables server **104** to select music files **114** and/or digital music licenses **116** from music library **122** that correspond to compact disc **116.** Secret key **216** is, for example, an arbitrarily selected hexadecimal string and is used as part of the authentication process as described further below.

- • The Appellant states, "Therefore, Appellant does not understand how the Examiner can

  reasonably assert that the Declaration, as set for in §2 of the Declaration, does not

  sufficiently address the specific claims."

  - o Please see the Examiner's comments above.

- • The Appellant states, "Specifically, the survey consisted of the Survey Card being mailed

  to at least 500 physicians in the Pittsburgh PA area."

   o No where within the declaration is the number of participants or the results of the survey found. Additional comments by the Appellant regarding "the majority of responding physicians" are also not found within the declaration.

- The Appellant states, "Accordingly, the fact that the aforementioned survey questions were answered in the affirmative should be evidence of an existing long-felt need for the claimed electronic prescription handling system, which therefore weighs in favor of overcoming the Examiner's obviousness rejection."

   o The Applicant failed to include the results and therefore whether or not the results "should be evidence of an existing long-felt need" is moot.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/N. R. S./

Examiner, Art Unit 3626

6/24/2009

/C. Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626

Conferees:

/C. G./

C. Luke Gilligan

Supervisory Patent Examiner, Art Unit 3626

Vincent Millin /vm/

Appeals Practice Specialist